

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

### **II. Disposition of Claims**

Claims 1-4, 7-11, 14-18, 21, 22, 27, and 30 are pending in this application. Claims 5, 6, 12, 13, 19, and 20 have been cancelled herein. Claims 28 and 29 were cancelled in a prior response.

Claims 1, 3, 8-10, 15-17, 22, 27, and 30 have been amended herein. These amendments are supported by the specification as filed.

Claims 1-4, 7, 9-11, 14-18, and 21 stand rejected under 35 U.S.C. § 102(b). Claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30 stand rejected under 35 U.S.C. § 102(e).

### **III. Remarks Regarding Claim of Priority**

The Examiner has asserted that Applicants may not claim priority to U.S. Patent Application Serial No. 10/254,268 (the “‘268 Application”) because this application does not disclose the concept of a gel breaker comprising a degradable acid releaser. (*See* Office Action at page 2.) Applicants respectfully disagree.

In order to claim priority from an earlier-filed application, that application must disclose the claimed subject matter in a manner that complies with the requirements of 35 U.S.C. § 112, first paragraph, which requires that the disclosure “contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use [the invention], and . . . set forth the best mode contemplated by the inventor of carrying out his invention.” *See* MANUAL OF PATENT EXAMINING PROCEDURE § 201.11 (2004) (citing 35 U.S.C. § 112). The ‘268 Application discloses the use of breakers comprising certain “encapsulated acids and slowly soluble acid generating compounds,” that are included as “a breaker or crosslink delinker for causing the fluid to quickly revert to a thin fluid.” (*See* ‘268 Application at page 24, lines 13-21. (A copy of the cited pages of this application is enclosed for the Examiner’s convenience.)) This adequately supports and enables the use of an acid-releasing degradable material to produce an acid to reduce the pH and viscosity of a treatment fluid, as recited in Applicants’ claims, in accordance with the requirements of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants

respectfully request that the Examiner acknowledge the proper claim of priority for the present claims from the '268 Application.

**IV. Remarks Regarding Rejections of Claims Under 35 U.S.C. § 102(b)**

**A. Rejections of Claims Under 35 U.S.C. § 102(b) Over U.S. Patent No. 5,224,546**

Claims 1, 2, 4, 9, 11, 14-16, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,224,546 to Smith *et al.* ("Smith").

To form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). In this response, Applicants have amended claims 1, 9, and 16 to include the limitation that the acid-releasing degradable material be selected from the group consisting of lactides, poly(lactides), glycolides, poly(glycolides), substantially water-insoluble anhydrides, poly(anhydrides), derivatives thereof, and combinations thereof. *Smith* only discloses the use of esterified carboxylated chelators to reduce the viscosity of a fluid, and does not disclose any of the acid-releasing degradable materials recited in claims 1, 9, and 16, as amended herein. (*See Smith* at col. 4, ll. 58-68.)

Therefore, Applicants respectfully submit that independent claims 1, 9, and 16 are patentable over *Smith*. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers," and since claims 2, 4, 11, 14, 15, and 18 depend, either directly or indirectly, from claim 1, 9, or 16, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**B. Rejections of Claims Under 35 U.S.C. § 102(b) Over U.S. Patent No. 6,793,018**

Claims 1-4, 7, 9-11, 14, 16-18, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,793,018 to Dawson *et al.* ("Dawson").

To form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). In this response, Applicants have amended claims 1, 9, and 16 to include the limitation that the acid-releasing degradable material be selected from the group consisting of lactides, poly(lactides), glycolides, poly(glycolides), substantially water-insoluble anhydrides, poly(anhydrides), derivatives thereof, and combinations thereof. *Dawson* only discloses the use

of certain ester compounds to reduce the viscosity of a fluid, and does not disclose any of the acid-releasing degradable materials recited in claims 1, 9, and 16, as amended herein. (*See Dawson* at col. 6, ll. 61-65.)

Therefore, Applicants respectfully submit that independent claims 1, 9, and 16 are patentable over *Dawson*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-4, 7, 10, 11, 14, 17, 18, and 21 depend, either directly or indirectly, from claim 1, 9, or 16 these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**C. Rejections of Claims Under 35 U.S.C. § 102(b) Over U.S. Patent No. 5,813,466**

Claims 1-4 and 9-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,813,466 to Harris *et al.* (“*Harris*”).

To form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). In this response, Applicants have amended claims 1 and 9 to include the limitation that the acid-releasing degradable material be selected from the group consisting of lactides, poly(lactides), glycolides, poly(glycolides), substantially water-insoluble anhydrides, poly(anhydrides), derivatives thereof, and combinations thereof. *Harris* only discloses the use of enzymes and esters of specific acids and alcohols to reduce the viscosity of a fluid, and does not disclose any of the acid-releasing degradable materials recited in claims 1 and 9, as amended herein. (*See Harris* at col. 2, ll. 39-45; *id.* at col. 5, ll. 24-27.)

Therefore, Applicants respectfully submit that independent claims 1 and 9 are patentable over *Harris*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-4, 10, and 11 depend, either directly or indirectly, from claim 1 or 9 these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**V. Rejections of Claims Under 35 U.S.C. § 102(e)**

Claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0028976 by Philip D. Nguyen (“the Nguyen Application”). Applicants respectfully traverse these rejections. As

discussed in Section III. above, Applicants have properly claimed priority from U.S. Patent Application Serial No. 10/254,268, which was filed on September 25, 2002, prior to the filing date of the Nguyen Application. Therefore, the Nguyen Application does not constitute prior art to Applicants' claims, and Applicants respectfully request the withdrawal of the rejections over this reference.

**SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no fees due in association with this filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,



Robert A. Kent  
Registration No. 28,626  
Halliburton Energy Services, Inc.  
2600 South Second Street  
P.O. Drawer 1431  
Duncan, OK 73536-0440  
Telephone: 580-251-3125

**ATTORNEY FOR APPLICANTS**

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